

Docket No.: RSW920010183US1 (7161-017U)

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Virinder BATRA, et al.	:	Confirmation Number: 3519
	:	
Application No.: 10/077,012	:	Group Art Unit: 2145
	:	
Filed: February 15, 2002	:	Examiner: A. Choudhury
	:	
For:		COMMON LOCATION-BASED SERVICE ADAPTER INTERFACE FOR LOCATION BASED SERVICES

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Notification of Non-Compliant Appeal Brief dated March 20, 2008 (hereinafter the First Notice).

## REMARKS

On page 2 of the First Notice, the following was stated:

The summary of claimed subject matter fails to separately refer each independent claim (1, 3 and 5) to the specification by page and line number. The independent claims should not be grouped together.

For ease of reference, 37 C.F.R. § 41.37(c)(1)(v), which describes the requirements for the Summary of Claimed Subject Matter section of the Appeal Brief, is reproduced below:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

This subsection includes two sentences, and notably, the second sentence (i.e., starting "[f]or each independent claim ...") refers to claims that include "means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph." However, none of the claims (either independent or dependent) argued separately in the Argument section of the Appeal Brief include claim language described in the sixth paragraph of 35 U.S.C. § 112. Thus, only the first sentence (i.e., the underlined sentence) of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief.

Since only the first sentence of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief, what is required of the Summary of Claimed Subject Matter section of the Appeal Brief is: (i) a concise explanation of the subject matter in each of the independent claims and (ii) the concise explanation refers to the specification and to the drawings. Referring to the present Application, claims 1, 3, and 5 are independent. Referring to the last full paragraph on page 2 of

the Appeal Brief, independent claims 1 and 5 were concisely explained, and referring to the paragraph spanning pages 2 and 3 of the Appeal Brief, independent claim 3 was concisely explained. Moreover, each of the concise explanations included several references to the specification by page and line number and to the drawings by reference characters. Thus, Appellants submit that the Appeal Brief meets the requirements of 37 C.F.R. § 41.37(c)(1)(v).

Referring to the above-reproduced passage found on page 2 of the First Notice, it is stated that "[t]he independent claims should not be grouped together." Appellants disagree with this statement and note that this statement is without legal basis. Appellants respectfully submit that there is nothing in 37 C.F.R. § 41.37(c)(1)(v) that prevents independent claims 1 and 5 from being concisely explained together (i.e., grouped).

By comparison, attention is directed to 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Appellants have referred to 37 C.F.R. § 1.104 since this Rule governs the content of an Examiner's Action. Of note is the requirement that "each rejected claim [be] specified." Referring to page 2 of the Sixth Office Action (i.e., "[w]ith regards to claims 1 and 5, Requena teaches ..."), the Examiner grouped together claims 1 and 5 in the statement of the rejection. Thus, in the Sixth Office Action, the Examiner has essentially argued together (i.e., grouped) independent claims 1 and 5. This practice of arguing together nearly identical claims is ubiquitous throughout the Patent Office. This practice is ubiquitous because repeating, word-for-word, identical rejections is wasteful.

Referring again to 37 C.F.R. § 41.37(c)(1)(v), which requires "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal," Appellants submit that both this requirement and the requirement in 37 C.F.R. § 1.104(c) require only that each claim be specified and not that each claim be *separately* specified, as asserted in the First Notice. Appellants are unclear as to the difference between the requirements set forth in 37 C.F.R. § 1.104(c) and the requirements set forth in 37 C.F.R. § 41.37(c)(1)(v) that permits an Examiner to argue similar independent claims together yet allegedly prevents Appellants from concisely explaining similar independent claims together.

If a subsequent Notification of Non-Compliant Appeal Brief is to be issued, Appellants respectfully request a detailed explanation as to why it is believed that 37 C.F.R. § 41.37(c)(1)(v) requires nearly identical independent claims be *separately* concisely explained in the Summary of Claimed Subject Matter section of the Appeal Brief.

Appellants would also like an explanation as to why this rule has been inconsistently applied. The undersigned is aware of dozens of Appeal Briefs that have been submitted in this manner that have not been considered non-compliant. In this regard, Appellants note that the present Appeal Brief is the third Appeal Brief filed in the present application. However, each of the first two Appeal Briefs were not considered non-compliant despite having identical Summary of Claimed Subject Matter sections as the present Appeal Brief and despite being subject to the same requirements.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: April 3, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320